

REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-6, 8-19 and 21 are pending and stand rejected.

Claims 1, 3-4, 6, 8, 10-14, 19 and 21 stand rejected under 35 USC 102(e) as being anticipated by Brown (USP no. 6,973,663).

Applicant respectfully disagrees with and explicitly traverses the reason for rejecting the claims as Brown fails to disclose a material element recited in the claims. More specifically, the Office Action refers to Figure 11 of the Brown reference to show that Brown discloses the claim element "a means for communicating said recommendation and said rationale to the user, wherein the communication for said rationale to the user is performed in a conversational tone."

However, a reading of this description of Figure 11 (see col. 16, lines 44-51) reveals that Brown teaches "a method of displaying why certain program titles were displayed as being similar. The explanation 158 contains a preference indicator 160 which is inserted into the digital image. It is also possible to calculate the percentage of common attributes... which are contained in the list of saved preferred television programs or a user selection history list."

Hence, Brown teaches a system wherein the explanation is displayed to a user in a clinical manner, which is not the manner (conversational tone) recited in claim 1, for example.

The specification describes on page 8, lines 17-19, for example, the "rationale is not presented in a clinical manner, but rather in a conversational tone ... As an example, in recommended [sic] a new program, Dracula 2000, the systems **tells** the user that ..." (emphasis added). Accordingly, a system is described that tells, i.e. audio output, the rationale for program selection. Support for an audio presentation is found in Figure 3, wherein the program recommendations with rationale are provided to set-top terminal/television 150. The television 150 is known to have an audio output feature that may be utilized to provide the recommendations in a conversational tone.

It is well recognized that to constitute a rejection pursuant to 35 USC §102, i.e., anticipation, all material elements recited in a claim must be found in one unit of prior art.

Brown cannot be said to anticipate the present invention, because Brown fails to disclose each and every element recited. As shown, Brown fails to provide a means for communicating the rationale in a "conversational tone," as is recited in the claims.

At least for this reason, applicant submits that the rejection of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

With regard to the remaining independent claims, these claims recite subject matter similar to that recited in claim 1 and were rejected for the same reason used in rejecting claim 1. Thus, for the remarks made in response to the rejection of claim 1, which are also applicable in response to the rejection of the remaining independent claims, and reasserted, as if in full, herein, applicant submits that the reason for rejecting these claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

With regard the remaining claims these claims ultimately depend from the independent claims, which have been shown to contain subject matter not disclosed by, and, hence, allowable over, the reference cited. Accordingly, these claims are also allowable by virtue of their dependency upon an allowable base claim.

Accordingly, applicant respectfully requests withdrawal of the rejection and allowance of the claims.

Claims 2 and 15 stand rejected under 35 USC 103(a) as being unpatentable over Brown in view of Ellis (USP no. 6,898,762). Claims 5 and 18 stand rejected under 35 USC 103(a) as being unpatentable over Brown in view of Lawlor (USP no. 5,758,259).

Applicant respectfully disagrees with and explicitly traverses the reason for rejecting the claims.

A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

In this case, the aforementioned claims depend from the independent claims, which have been shown to contain subject matter not disclosed by Brown. The cited references fail to provide any teaching or suggestion to correct the deficiency noted in the primary reference. Hence, even if there were some motivation to combine the teachings of the cited references, the device created from the combination of Brown and the other cited references fails to teach all the features recited in independent claims, and consequently, the aforementioned dependent claims.


Accordingly, the invention recited in the aforementioned claims is not rendered obvious by the teachings of the cited references. For at least this reason applicant submits that the reason for the rejection has been overcome and respectfully requests that the rejection be withdrawn.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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